

Applicant : Subrahmanyam, et al.
Serial No. : 10/676,275
Filed : September 30, 2003
Page : 9 of 12

RECEIVED
CENTRAL FAX CENTER

Attorney's Docket No.: 15786-019001

SEP 21 2006

REMARKS

Claims 1-30 are pending, with claims 1, 16 and 21 being in independent form. Reconsideration and allowance of the above-referenced application are respectfully requested in light of the following remarks.

Claims 2-10, 17-19, and 22-25 have been amended in accordance with the Examiner's Amendment accompanying the Notice of Allowance mailed January 25, 2006. The Examiner has noted that these amendments were authorized by Mr. Kirkland in a phone conference on January 19, 2006.

Rejection under 35 U.S.C. § 101

Claims 1-30 stand rejected for allegedly reciting non-statutory inventions under 35 U.S.C. § 101. The rejection is respectfully traversed.

The Examiner asserts that claims 1-30 "consist solely of capturing information simply manipulates abstract ideas without practical application in the technological arts" and "raises a question as to whether the claimed method is directed merely to an abstract idea that is not tied to a technological art, environment, or a machine which would result in a practical application producing a concrete, useful, and tangible result."

The Applicant disagrees.

First, the Examiner appears to be asserting a requirement that the claims satisfy a "technological arts" test. The Applicant calls the Examiner's attention to the precedential opinion of the Board of Patent Appeals and Interferences in Ex Parte Lundgren, Appeal No. 2003-2088, issued in October 2005, which states that "there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." Slip opinion, page 9.

Second, the Applicant submits that the claimed method, machine readable article, and apparatus do produce a useful, concrete, and tangible result. The result of the claimed method, etc. includes named sub-paths of a continuous path of an intermittent fillet weld. The sub-paths correspond to the portions of the intermittent fillet weld. See Specification, page 21, lines 17-24. The sub-paths may be representations of the portions of the intermittent fillet weld in a

Applicant : Subrahmanyam, et al.
Serial No. : 10/676,275
Filed : September 30, 2003
Page : 10 of 12

Attorney's Docket No.: 15786-019001

computing environment, but they correspond to welds that may be performed in the physical environment. Thus, the result of the claims is useful, concrete, and tangible. Therefore, the rejection of claims 1-30 should be withdrawn.

Rejection under 35 U.S.C. § 103(a)

Claims 1-30 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. US 2004/0122550 A1 ("Klimko, et al."). The rejection is respectfully traversed.

Claim 1. Claim 1 recites in part, "naming each sub-path, including its edges and vertices, employing the invariant weld bead generation direction."

The Applicant submits that Klimko does not disclose "naming each sub-path, including its edges and vertices, employing the invariant weld bead generation direction." The Examiner has not explained what in Klimko allegedly corresponds to this feature. *Cf.* MPEP § 707 ("When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."). Nevertheless, it appears to the Applicant that the Examiner means to say that this feature is met by the portion of Klimko that includes "developing a set of modeling of welds. With weld option of intermittent fillet, joint length, weld type, a CAD drawing, and other setting options ...[, and] a database for storing weld information and processing unit couple[d] to database."

Claim 1 requires the naming a sub-path of a weld bead. The development of a set of weld models and the various options, as disclosed by Klimko, involves developing a set of procedures for how a weld is to be performed in the physical environment. *See Klimko*, Abstract, ¶¶ 95-100. Klimko provides no teaching or suggestion for naming of a sub-path of a weld bead. Klimko also provides no teaching or suggestion that the developing of a set of weld procedures includes naming a sub-path of a weld. Therefore, Klimko does not teach or disclose this element of claim 1.

The Examiner also asserts that it is well known in the art to "have a continuous path to make connect the different edge" and that "each face have [sic] sub path." The Examiner appears to be taking official notice of facts that are allegedly well-known in the art. The

Applicant : Subrahmanyam, et al.
Serial No. : 10/676,275
Filed : September 30, 2003
Page : 11 of 12

Attorney's Docket No.: 15786-019001

Applicant calls the Examiner's attention to the requirement for the Examiner to support an assertion of common knowledge in the art with documentary evidence or "specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." *See* MPEP 2144.03(B).

Because Klimko and the common knowledge cited by the Examiner does not, individually or in combination, teach or suggest naming each sub-path and further does not teach or suggest naming edges and vertices of a sub-path, the Examiner has not made a *prime facie* case that claim 1 is obvious. Therefore, claim 1 is in a condition for allowance.

Claim 16. Claim 16 is directed to a machine readable article. The recited machine readable article includes machine executable instructions designed to enable an apparatus to, in part, name each sub-path of a weld bead, including the edges and vertices of each sub-path. Thus, claim 16 is in a condition for allowance for at least the reasons set forth above with respect to claim 1.

Claim 21. Claim 21 is directed to an apparatus comprising, in part, a storage medium having stored therein a plurality of instructions. The instructions are designed to enable the apparatus to, in part, name each sub-path of a weld bead, including the edges and vertices of each sub-path. Thus, claim 21 is in a condition for allowance for at least the reasons set forth above with respect to claim 1.

Claims 2-15, 17-20, and 22-30. Claims 2-15, 17-20, and 22-30 are dependent from, and incorporate the limitations of claims 1, 16, or 21, respectively. Therefore, claims 2-15, 17-20, and 22-30 in a condition for allowance for at least the reasons set forth above.

Applicant : Subrahmanyam, et al.
Serial No. : 10/676,275
Filed : September 30, 2003
Page : 12 of 12

RECEIVED
CENTRAL FAX CENTER

Attorney's Docket No.: 15786-019001

SEP 21 2006

Conclusion

For the reasons stated above, the pending claims are in a condition for allowance. Withdrawal of the claim rejections is respectfully requested. By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's arguments for the patentability of a claim should not be understood as implying or conceding that no other reasons for the patentability of that claim exist.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 9/21/2006

Andrew H. Leung
Andrew H. Leung
Reg. No. 55,374

Customer No.: 26181
Fish & Richardson P.C.
Telephone: (650) 839-5070
Facsimile: (650) 839-5071

50372789.doc